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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,297	04/25/2001	Jose A. Sobrado	020431.0772	7102

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Christopher W. Kennerly, Esq.  
Baker Botts L.L.P.  
6th Floor  
2001 Ross Avenue  
Dallas, TX 75201-2980

EXAMINER
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MAMMEN, NATHAN SCOTT

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/842,297

Applicant(s)

SOBRADO ET AL.

Examiner

Nathan S Mammen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7-14, 24-31, 41-48, 53-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The dependent claims (5, 22, 39) from which claims 7-14, 24-31 and 41-48 depend and the independent claims 53-55 recite that “each recommended option is selected from the group consisting of...a recommended purchase...a recommended auction...and a recommended reverse auction.” This limitation is an alternative limitation, i.e., the recommended option can be either one of these options. Thus, the aforementioned claims are indefinite when the claims recite positively the limitations “the auction” or “the reverse auction”, for it has not been positively set forth that the selected option is an auction or reverse auction.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1, 17-19, 34-36, 51, 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Beall et al., U.S. Patent 6,032,145.

The Beall '145 patent discloses a system, method and software providing a guided buying decision support. The system comprises a server (12) operable to interact with buyers to receive procurement parameters (300), an option generator (302) operable to receive procurement parameters and determine acceptable item-supplier combinations and specify a service through which it is possible to procure the item consistent with the parameters, and a manager application operable to initiate the service (see 302, "Add to Cart" tab).

Regarding claims 2, 17, 19, 34, 36, 51: The parameters includes a characteristic of the item (see, e.g., 300 – "bic pen red"). The system, method, and software are components of an electronic marketplace (col. 4, lines 10-45).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 15, 17-24, 32, 34-41, 49, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fish, U.S. Patent 6,195,652, cited by Applicant.

The Fish '652 patent discloses a system, method, and software proving guided decision support in an electronic marketplace environment (e.g., an online auction). The Fish '652 patent does not explicitly disclose that the system initiates procurement services; however, electronic marketplaces are well-known in the art, and one a particular item is located – either through a

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seller database search or an online auction search – the steps for procuring an item are obvious.

The system of the Fish '652 patent includes a server (see, generally, Fig. 2) operable to interact with buyers to receive procurement parameters (col. 10, lines 6-65), an option generator (col. 11, line 45-50) to receive the parameters and generate acceptable item-supplier combinations.

Regarding claims 2-7, 15, 17, 19-24, 32, 34, 36-41, 49, 51, 52: The procurement parameters include specifying characteristics or acceptable suppliers (172B). The server provides a display through which the buyer may input the parameters and a display through which the buyer may select an option (col. 10, lines 6-31). The impact of the procurement parameters on the recommended options are displayed in substantially real time (col. 7, lines 29-44). The recommended options include a recommended purchase (col. 10, line 32-40) and a recommended auction (col. 11, lines 38-50). The auction circumstances include date the auction is scheduled to complete (col. 11, line 41). The system receives status data for the buyer specifying the procurement parameters (col. 11, line 45-50). The system is a part of an electronic marketplace (e.g., an online auction).

As stated previously, the Fish '652 does not disclose details of procurement steps or the electronic marketplace. The system of the Fish '652 patent is applicable to electronic marketplaces, as evidenced by the patent's references to various electronic marketplace formats. Thus, since electronic marketplaces are well-known in the art, applying details of electronic marketplaces to the Fish '652 patent would be obvious to one having ordinary skill in the art.

7. Claims 8-14, 16, 25-31, 33, 42-48, 50, 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fish, U.S. Patent 6,195,652, as applied to claims 1, 18, 35 above, and further in view of WO 00/34886 patent publication.

The invention is obvious in view of the system disclosed by the Fish '652 patent, as stated in paragraph 6 above. What the Fish '652 patent does not disclose as a component of the probability of success in the auctions and reverse auctions. The WO 00/34886 patent publication teaches that it is known in the art of electronic commerce to provide a system with the ability to generate the probabilities of success and to recommend actions to a buyer based on the probability of success. See pages 6-15. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system and method disclosed by the Fish '652 patent with the probability calculator taught in the WO 00/34886 patent publication, in order to increase the likelihood of success for a user of the system of the Fish '652 patent.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Sammon, Jr., et al., U.S. Patent 6,012,051, discloses an analytic decision processor for a consumer profiling system. See Fig. 1. Danish et al., U.S. Patent 5,715,444, discloses a method for executing a guided parametric search. See Abstract. Fish, U.S. Patent 6,035,294, is the parent application to the Fish '652 patent cited above and discloses a system allowing a user to add parameters for describing items. See Abstract. Greef et al., U.S. Patent 5,897,639, discloses an electronic catalog database system which allows a consumer to select parameters. See Figs. 2 and 3.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (703) 306-5959. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at (703) 308-3870. The fax number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-1113.

  
**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group 3600**

**NSM**  
**9/29/03**

Nathan S. Mammen